

REMARKS

I. Formalities

Claims 1-13 and 18-32 have been elected herein, with traverse.

II. Response to the Restriction Requirement

A restriction of Applicants' claims was required under 35 U.S.C. §121 for the following groups of claims:

I. "Claims 1-13 and 18-25, drawn to a method of making a semiconductor device, classified in class 438, subclass 253"; and

II. "Claims 14-16 and 26-32, drawn to a semiconductor device, classified in class 257, subclass 315."

The Office Action does not refer to claim 17. Claim 17 was filed with the original specification at the same time and in the same document as were claims 1-16 and 18-32. Claim 17 is drawn to a semiconductor device, just as are claims 14-16. Accordingly, Applicants respectfully submit that the Office Action should have included claim 17 in Group II.

Claims 26-32 are drawn to a method of making a semiconductor device, but the Office Action erroneously identifies claims 26-32 as being drawn to a semiconductor device rather than to a method of making a semiconductor device. Applicants respectfully submit that the Office Action should have included claims 18-32 in Group I rather than in Group II.

Based on the foregoing, Applicants will assume herein that Group I consists of claims 1-13 and 18-32 (the method claims), and that Group II consists of claims 14-17 (the device claims).

As required by the Office Action, Applicants elect, subject to a traverse that follows hereafter, to prosecute the method claims of Group I, i.e., claims 1-13 and 18-32.

Applicants traverse the subject restriction requirement on the grounds that it fails to comply with the express language of 35 U.S.C. §121, which states that a restriction is only proper between claims that are both "independent and distinct." The Office Action alleges that

restriction is required because Applicants' claims are "distinct." However, it has not been alleged that Applicants' claims are "independent and distinct," and yet this requirement is a prerequisite under the Patent Statutes before the Commissioner's discretion may be exercised under 35 U.S.C. §121.

In an effort to justify the Restriction Requirement, it is alleged that the Group I and II inventions are distinct because "the product as claimed can be made by another and materially different process," and because an electrode material can be grown rather than deposited. It is respectfully submitted that the claims are sufficiently definite so that there should be no question as to what is being claimed. There is no reason to attempt to read limitations into the claims that are not set out therein. It is respectfully submitted that it is improper to base a Restriction Requirement upon conjecture as to what could be called for in Applicants' claims.

Furthermore, it is strenuously urged that the alleged different Patent Office classifications of Applicants' claims cannot and should not be relied upon as the basis for a Restriction Requirement. It is a well-known fact that, in the interest of administrative efficiency, the prior art in the Patent Office is reclassified on a continuing basis. Thus, a given group of claims might be classified identically one day only to be classified separately the next day due to a Patent Office reclassification project. It is respectfully submitted that Congress never intended (by enacting 35 U.S.C. §121) that the jurisdictional requisite of "independent and distinct" depend upon and vary in accordance with Patent Office reclassification programs. To suggest otherwise would be to suggest that Congress enacted 35 U.S.C. §121 with the intent that the jurisdiction of the Commissioner in restriction matters could be enlarged by the Commissioner himself, and this clearly would be improper on Constitutional grounds.

Still further, maintaining the Restriction Requirement and forcing Applicants to file a divisional application to include the non-elected claims only serves to increase the workload upon the U.S. Patent and Trademark Office and to increase the expenses incurred by Applicants. Accordingly, maintaining the present Restriction Requirement does not benefit anyone.

Also, it is noted that restriction is never mandatory and is discretionary under 35 U.S.C. §121 only when "two or more independent and distinct" inventions are claimed. It is respectfully submitted that the restriction requirement should be removed because there is not even alleged a

valid ground under 35 U.S.C. 121 for exercising the Commissioner's discretion in requiring the restriction.

Therefore, it is respectfully submitted that the Restriction Requirement should be removed because there has not been alleged a valid ground under 35 U.S.C. §121 for exercising the Commissioner's discretion and requiring the restriction. Although the provisional election of the claims of Group I, i.e., claims 1-13 and 18-32, is affirmed, the Restriction Requirement is respectfully traversed, and reconsideration and withdrawal of the requirement for restriction is respectfully requested.

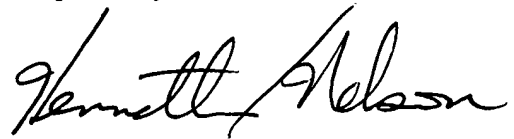
CONCLUSION

Based on the foregoing remarks, it is respectfully submitted that the Restriction Requirement should be removed. Although the election of the claims of Group I, i.e., claims 1-13 and 18-32, is affirmed, the Restriction Requirement is respectfully traversed, and reconsideration and withdrawal of the requirement for restriction is respectfully requested.

No fees are believed to be due with this Response to Office Action. However, the Commissioner for Patents is hereby authorized to charge any fees due by reason of this paper, or credit any overpayment, to Account No. 02-4467.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants invite Examiner Pham to call the undersigned attorney at the Examiner's convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kenneth A. Nelson". The signature is fluid and cursive, with the first name "Kenneth" and last name "Nelson" clearly distinguishable.

BRYAN CAVE LLP
Two North Central Avenue
Suite 2200
Phoenix, AZ 85004-4406

Kenneth A. Nelson
Attorney for Applicants
Reg. No. 48,677
Tel. (602) 364-7000